



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

SUSAN M. ABERNATHY ET AL.

Serial No.: 10/743,932

GROUP ART UNIT:

Filed: December 23, 2003

EXAMINER:

For: FINISHED LUBRICANT COMPRISING
LUBRICATING BASE OIL WITH HIGH
MONOCYCLOPARAFFINS AND LOW
MULTICYCLOPARAFFINS

P. O. Box 6006
San Ramon, CA 94583-0806

NOTICE OF NEW REFERENCES CITED

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to 37 CFR 1.105 and MPEP 707.05(b), the new references listed on attached PTO/SB/08a (05-03) are brought to the Examiner's attention for consideration in the examination of the above-identified application.

Since this supplemental information disclosure statement is being filed before the first office action on the merits pursuant to 37 C.F.R. Section 1.97(b)(3), no fee under C.F.R. Section 1.17(p) should be required. However, should a fee be required, the Commissioner is hereby authorized to charge any fees to Deposit Account Number 03-1620.

CERTIFICATE OF MAILING (37 C.F.R. § 1.8a)

I hereby certify that I have a reasonable basis for believing that this correspondence (along with any paper referred to as being attached or enclosed) will be deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

on Sept. 24, 2004

Diana K. Ponce
Diana K. Ponce

New reference No. 3 is a recently published PCT patent application, WO2004033606A1. Reference No. 4 is the "Product Brochure of Shell MDS (Malaysia) Sdn Bhd" dated May 1995. Copies of these two new references are enclosed. Applicants request that the Examiner review the new references and initial form PTO/SB/08a (05-03). This communication also provides pertinent features of the second new reference.

R E M A R K S

Pertinent Features of Second Newly Cited Reference

On the eighth page of Product Brochure of Shell MDS (Malaysia) Sdn Bhd the Shell MDS waxy raffinate is referred to. The table refers to "dewaxed oil" having a VI of 148 and a kinematic viscosity at 100°C of 5.15 mm²/s. The applicants have in their possession a sample identified a Shell MDS waxy raffinate dating from July 1996. This material was obtained from Shell as a normal commercially available product. A sample of the 1996 Shell MDS waxy raffinate was subjected to a solvent dewaxing procedure in our laboratory. Properties of this dewaxed oil are set forth in the following table. This data is the result of applicants' laboratory solvent dewaxing and analysis of the sample. Properties of this dewaxed oil were not previously available to the public.

| Property of Dewaxed Oil | Value |
|------------------------------|--------|
| Viscosity Index | 154 |
| Kinematic Viscosity at 100°C | 5.146 |
| Aromatics, Wt% | 0.0667 |
| Pour Point, °C | -8 |
| FIMS, Wt% of Molecules | |
| Paraffins | 81.9 |
| Monocycloparaffins | 18.1 |
| Multicycloparaffins | 0.0 |
| Total | 100.0 |
| Noack Volatility | 7.66 |

Respectfully submitted,



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AWK:SMA:dkp
Enclosures
September 24, 2004

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Substitute for form 1449A/PTO

INFORMATION DISCLOSURE
STATEMENT BY APPLICANT

(use as many sheets as necessary)

Sheet

1 of 1

Complete if Known

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|----------------------|--------------------|
| Application Number | 10/743,932 |
| Filing Date | December 23, 2003 |
| First Named Inventor | Susan M. Abernathy |
| Art Unit | |
| Examiner Name | |

Attorney Docket Number G-0135B

U.S. PATENT DOCUMENTS

| Examiner Initials * | Cite No. ¹ | Document Number | Publication Date MM-DD-YYYY | Name of Patentee or Applicant of Cited Document | Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear |
|---------------------|-----------------------|--|--------------------------------|--|---|
| | | Number - Kind Code ² (if known) | | | |
| | 1 | US-2004/0108249 | 06-10-2004 | Cody et al. | |
| | 2 | US- 2004/0108248 | 06-10-2004 | Cody et al. | |
| | | US- | | | |
| | | US- | | | |

FOREIGN PATENT DOCUMENTS

| Examiner Initials* | Cite No. ¹ | Foreign Patent Document | Publication Date MM-DD-YYYY | Name of Patentee or Applicant of Cited Document | Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear | T ⁶ |
|--------------------|-----------------------|--|--------------------------------|---|--|----------------|
| | | Country Code ³ - Number ⁴ - Kind Code ⁵ (if known) | | | | |
| | 3 | WO2004033606 | 04-22-2004 | ExxonMobil | | |
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OTHER PRIOR ART -- NON PATENT LITERATURE DOCUMENTS

| | | | |
|---------------------|-----------------------|---|----------------|
| Examiner Initials * | Cite No. ¹ | Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published. | T ² |
| | 4 | "Product Brochure of Shell MDS (Malaysia) Sdn Bhd" dated May 1995 | |
| | | | |

Examiner Signature

Date Considered

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. 1 Applicant's unique citation designation number (optional). 2 See Kinds Codes of USPTO Patent Documents at www.uspto.gov or MPEP 901.04. 3 Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). 4 For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. 5 Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. 6 Applicant is to place a check mark here if English language Translation is attached.

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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